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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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L. Lloyd Williams

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VAN DYKE, GARDNER, LINN AND BURKHART, LLP
2851 CHARLEVOIX DRIVE, S.E.
P.O. BOX 888695
GRAND RAPIDS, MI 49588-8695

EXAMINER

ANWAH, OLISA

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,971

Applicant(s)

WILLIAMS, L. LLOYD

Examiner

Olisa Anwah

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 16-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 52-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 and 41-65 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. A detailed examination of the originally presented claims 1-15 was mailed on March 31, 2004 as Paper No. 5. In response, the applicant filed an amendment on June 29, 2004 as Paper No. 6 that introduced new claims 41-65.

Newly presented claims 41-51 are patently distinct. Specifically, these claims recite significantly different limitations than claims 1-15 and 52-65, thus creating extensive and facially objective evidence of patentable distinctness.

In addition, administrative burden exists because the newly presented claims have different classifications, fields of search, and status in the art.

A restriction requirement under the above circumstances has several benefits. The restriction requirement promotes a clear and complete prosecution history of a single, original invention. The requirement promotes the quality, administrative determination of patentability for both the applicant and for the public.

Therefore, the following restriction requirement will be set forth based upon election by original presentation.

Election/Restrictions

2. Newly submitted claims 41-51 are directed to inventions that are independent or distinct from claims 1-15 and 52-65 for the following reasons:

Description of the Separate Inventions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121.

Invention I: Claims 1-15 and 52-65 are drawn to a method of providing direct call connection to a service subscriber's voice mailbox.

Invention II: newly presented claims 41-51, drawn to a method of providing one of a web page and an electronic mail message.

Classification and Field of Search

4. Invention I includes classification in class 379, subclass 88.26, recording voice message from non subscriber caller. Note also that Invention I could be classified in numerous other class/subclasses corresponding to the multiple and specific features recited (e.g., see claim 2). The field of search for Invention I does not include the field of search for Invention II as discussed below.

Invention II includes classification in class 709, subclass 206, processing user data in response to a demand to transfer data between the computers (e.g., electronic mail messaging). The field of search for Invention II does not include the field of search for the Invention I as discussed above.

Separate Status in the Art

5. A separate field of search (as discussed above) also shows a separate status in the art. MPEP § 808.02.

Evidence of Separate Status in the Art and Field of Search

6. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search. MPEP §808.02. In the instant case,

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Holt, U.S. Patent No. 6,711,243 (hereinafter Holt) relates to the subject matter claimed in claim 52 (col. 5, lines 1-25).

Holt is classified under class 379/88.25. On the other hand, Tov et al, U.S. Patent Application Publication No. 2002/0152402

(hereinafter Tov) is relevant to the subject matter claimed in claim 41 (see paragraph 00410). Tov is classified under class 713/201.

The Separate Inventions are Subcombinations

Usable Together Having Separate Utility

7. Inventions I and II are related as subcombinations disclosed as usable together in a single system for providing a voice mail interface.

The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility as a system for providing a voice mail interface via a directory service. (see claim 52). Invention II has separate utility as a system for providing a click to voice mail option on one of a web page and an electronic mail message. See MPEP § 806.05(d).

Reasons for Requiring the Restriction

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification for the reasons given above, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for one Invention is not required for the other Inventions for the reasons given above, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter for the reasons given above, restriction for examination purposes as indicated is proper.

Constructive Election by Original Presentation

9. Since applicant has received an action on the merits for the originally presented Invention I (drawn to claims 1-15), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Invention II (drawn to claims 41-51) are withdrawn from

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consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 819 and 821.03.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in-
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

11. Claims 1-3, 6-8, 11, 14, 15, 52 and 53 are rejected under 35 U.S.C. § 102(e) as being anticipated by Holt.

Regarding claim 1, Holt discloses a method of providing direct access to a voice mail system (VMS) hosting a voice mail box associated with a service subscriber (col. 5, lines 5-25), the method comprising the steps of:

formulating a call set-up message for initiating the establishment of a call connection to the VMS without first attempting to complete a call to the service subscriber, the

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call set-up message having a format reserved for a redirected call set-up message issued by a service switching point (SSP) in response to an uncompleted call to the service subscriber (col. 5, lines 20-45 and col. 7, lines 25-45); and

issuing the call setup message into a common channel signaling (CCS) network to initiate the establishment of the call connection directly to the voice mail box of the service subscriber (col. 5, lines 45-65 and col. 7, line 45 to col. 8, line 15).

Regarding claims 2 and 3, see col. 6, lines 1-10. Also see col. 7, line 25 to col. 8, line 15.

Claim 6 is rejected for the same reasons as claim 1.

Claim 7 is rejected for the same reasons as claim 2.

Claim 8 is rejected for the same reasons as claim 3.

As for claims 11, 14 and 15 see col. 6, lines 25-60. Also see col. 7, line 25 to col. 8, line 15.

Claim 52 is rejected for the same reasons as claim 1.

Regarding claim 53, see col. 6, lines 25-60 and col. 7, line 25 to col. 8, line 15.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 12 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Holt in view of Tov.

Regarding claim 12, Holt discloses receiving a connection request message that conforms to a predefined format and includes directory numbers for the requesting party, service subscriber and VMS (col. 5, lines 25-65 and col. 7, line 25 to col. 8, line 15). Holt fails to teach receiving over an Internet protocol (IP) connection, from a server on the Internet adapted to receive click-to-voice mail notifications from at least one worldwide web page. However Tov discloses this limitation (paragraph 0041). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Holt with the web page taught by Tov. This modification would have improved flexibility and universality by allowing a caller to connect to the subscriber or a subscriber service such

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as voice-mail, without having to become a subscriber him/herself (see paragraph 0041 of Tov).

Regarding claim 13, see col. 6, lines 25-60 and col. 7, line 25 to col. 8, line 15 of Holt.

Claim 54 is rejected for the same reasons as claim 12.

Claim 55 is rejected for the same reasons as claim 1.

Regarding claims 56-63, see col. 5, lines 45-65 and col. 7, line 25 to col. 8, line 15 of Holt.

14. Claims 5 and 10 are rejected under 35 U.S.C § 103(a) as being unpatentable over Holt in view of Russell, Travis.

Signaling System #7 New York: McGraw Hill, 2000 (hereinafter Russell).

With respect to claim 5, Russell fails to teach inserting a redirecting reason code into a redirection information parameter, the reason code being a default value indicating that the reasons for redirection is unknown or not available. However Russell discloses this limitation (see page 461). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Holt with the reason code taught by Russell. This modification allows for a parameter that provides information as to why the call was diverted and the nature of the call as suggested by Russell (page 496).

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Claim 10 is rejected for the same reasons as claim 5.

15. Claims 4 and 9 are rejected under 35 U.S.C § 103(a) as being unpatentable over Holt in view of Brunson, U.S. Patent No. 4,996,704 (hereinafter Brunson).

Regarding claim 4, Holt fails to teach a step of inserting a redirecting reason code into a redirection information parameter, the reason code being used by the VMS to select a voice mail prompt to play to the calling party. However Brunson discloses this limitation (see col. 3, lines 10-45). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Holt with the VMS taught by Brunson. This modification would have improved user friendliness by playing outgoing announcements to specific callers as suggested by Brunson (see abstract).

Regarding claim 9, Holt does not explicitly disclose inserting a redirecting reason code into a redirection information parameter, the redirecting reason code identifying the IAM as a request to leave a voice message with a direct to voice mail call. However Brunson discloses this limitation (col. 3, lines 10-45). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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modify Holt with the redirecting reason code taught by Brunson. This modification provides information as to why the call was diverted and the nature of the call as suggested by Brunson (col. 3, line 25).

16. Claim 65 is rejected under 35 U.S.C § 103(a) as being unpatentable over Holt combined with Tov in further view of D'Apuzzo et al, U.S. Patent No. 5,450,476 (hereinafter D'Apuzzo).

Regarding claim 65, the combination of Holt and Tov teaches permitting a requesting party to communicate an identifier used to locate a directory record associated with the VMS service subscriber (see col. 5, lines 1-20 and col. 7, line 25 to col. 8, line 15 of Holt). Holt combined with Tov fails to teach providing the requesting party with an option to be connected directly to the VMS service subscriber's voice mail box after the record is located. However D'Apuzzo discloses this limitation (see 170). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Holt and Tov with the providing method taught by D'Apuzzo. This modification would have made the directory service of Holt more user friendly by

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playing a recorded message before routing the call to a voice mail system as suggested by D'Apuzzo.

Response to Arguments

17. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 703-305-4814. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

O.A

Olisa Anwah
Patent Examiner
September 17, 2004


ROLAND FOSTER
PRIMARY PATENT EXAMINER